

Docket No.: WOLFRUM
Serial No.: 09/669,236

REMARKS

The last Office Action of November 26, 2001 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-16 are pending in the application.

It is noted that claim 16 is rejected under 35 U.S.C Section 101 because the claimed recitation of a use is set forth without setting any steps. The claims are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7 and 16 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 6,171,785 (hereinafter "Higuchi").

Claims 8-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Higuchi in view of U.S. Pat. No. 6,121,603 (hereinafter "Hang")

REJECTION OF CLAIM 16 UNDER 35 U.S.C. §101

Applicant has cancelled claim 16, so that the rejection thereof is obviated.

Withdrawal of the rejection of claim 16 under 35 U.S.C. §101, is thus respectfully requested.

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**REJECTION OF CLAIMS 1-5, 7- 8, 10-11 AND 16 UNDER 35 U.S.C. §112,
SECOND PARAGRAPH**

Applicant has cancelled claims 1-16 so that any rejection thereof are thereby obviated.

Withdrawal of the rejection of claims 1-5, 7-8, 10-11 and 16 under 35 U.S.C. §112, second paragraph is thus respectfully requested.

**REJECTION OF CLAIMS 1-7, 16 UNDER 35 U.S.C. §102(b) AS BEING
ANTICIPATED BY HIGUCHI.**

Applicant has cancelled claims 1-7 and 16 and has presented new claim 17 setting forth the method and method steps applicant considers to be his invention.

Claim 17 as presently submitted is reciting the method steps, which the Examiner found lacking in prior claim 1. In particular, the claim sets forth that the sample containing the DNA and/or the RNA sequences are free from fluorescent additives. Support for this is found on page 2, lines 7, 8 and 9 of the description. The gist in applicant's' invention lies in the fact that a binding agent such as a fluorescent dye is not used. The new claim 17 clearly states that the sample is free of fluorescent additives.

Higuchi, on the other hand, teaches only the use of measuring amplified DNA or RNA sequences with the aid of fluorescence additives. This is also

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clearly set forth in the abstract. As such, Higuchi discloses and claims a different method of detection and measuring from that claimed by applicant. The Examiner states that Higuchi uses "light scattering" for monitoring. The Examiner also stated Higuchi uses "a spectra fluorometer measuring light scattering" which indicates that the method relies on a fluorescent agent. Furthermore, Higuchi operates by introducing detectable DNA binding agents into the amplification reaction, which agents produce a detectable signal that is enhanced upon binding double-stranded DNA. The binding agent is fluorescent dye, or an intercalating dye, part of the prior art. Higuchi teaches the addition of agents that produce the signal. In contrast, the invention teaches not to add any agents or additives that produce a signal.

It is believed that the new claim 17 thus clearly distinguishes over Higuchi.

Withdrawal of the rejection of claims 1-7 and 16. under 35 U.S.C. §102(b) is therefore respectfully requested.

REJECTION OF CLAIMS 8-13 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER HIGUCHI IN VIEW OF HANG.

Applicant has cancelled claims 8-15 directed to the device. In view of the cancellation of these claims, the Examiner's rejection based on Higuchi in view of Hang has been obviated.

Withdrawal of the rejection of claims 8-15 under 35 U.S.C. §103(a) and allowance thereof are thus respectfully requested.

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**REJECTION OF CLAIMS 14-15 UNDER 35 U.S.C. §103(a) AS BEING
UNPATENTABLE OVER HIGUCHI IN VIEW OF LEHNEN**

Applicant has cancelled claims 14-15 directed to the device. In view of the cancellation of these claims, the Examiner's rejection based on Higuchi in view of Lehnen has been obviated.

Withdrawal of the rejection of claims 8-15 under 35 U.S.C. §103(a) and allowance thereof are thus respectfully requested.

GENERAL COMMENTS

Submitted herewith are a new Power of Attorney, the prior Power of Attorney having been withdrawn by the inventors. Submitted herewith is also a separate Request to Change Mailing Address and a Request for Corrected Filing Receipt, in order to rectify the incorrect dates stated on the receipt.

In this connection, it is noted that the Examiner has acknowledged applicants' claim for priority but questioned the dates of the priority application. Applicants state that the correct dates of the priority applications are set forth in the declaration signed by the inventors. Thus, the German priority application DE 198 14 68.2 was filed on April 1, 1988 and the International application PCT/EP99/02242 was filed on April 1, 1999. Apparently a corrected filing receipt has been requested by the prior attorneys and received, but the date was not

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corrected. The paragraph indicating the claim of priority has been added to the application by the above amendment.

It is also noted that the Examiner has not made of record the priority document. A copy of the priority document was ordered to have been sent as part of the PCT procedure. It is believed that the priority document has been forwarded by the filing authority to the Patent Office. Applicant believes that the issues directed to the claim of priority has been addressed and obviated, however if there are any remaining issues, the applicant respectfully requests to be apprised of any omission.

CONCLUSION

Applicant believes that when the Examiner reconsiders the claims in the light of the above comments, he will agree that the invention is in no way properly met or anticipated or even suggested by any of the references however they are considered.

None of the references discloses a method of measuring amplified DNA and/or RNA sequences without fluorescence agents.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

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Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

The Commissioner is hereby authorized to charge fees, which may be required, or credit any overpayment to Deposit Account No. 06-0502.

Respectfully submitted,

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